



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/009,399      | 09/16/2002  | Phillip Mackie       | 2625-1-001          | 1754             |

7590 01/31/2006  
Klauber & Jackson  
Continental Plaza  
411 Hackensack Avenue  
Hackensack, NJ 07601

EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT PAPER NUMBER

1773

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,399

Applicant(s)

MACKIE ET AL.

Examiner

D. S. Nakarani

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 16 and 17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8, 10-12, 16 and 17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claim 10 is objected to because of the following informalities: Claim 10, line 1, the word “function” should read -- functional--. Appropriate correction is required. Applicants are requested to review entire specification including claims for any other error.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8, 10-12, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fail to provide support for the limitation “first functional groups are terminal reactive groups or reactive groups not directly linked to the polymer backbone” in claim 1, lines 8-9. The support for this limitation, applicants state that it is clearly an inherent feature of all the compounds exemplified in the specification. These arguments are not persuasive because in Example 6, neither polyvinyl acetate nor polymethylhydrogen siloxane has terminal reactive groups or reactive groups not directly linked to the polymer backbone. Therefore afore said limitation constitute new matter. Further more negative limitation “reactive groups not directly linked to the polymer backbone” does not

Art Unit: 1773

appear in the originally filed specification. Therefor it constitutes new matter (see MPEP 2173.05(i)).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, line 2, the polyethyleneglycol (PEG) as being functional group can not be understood. How silanes or siloxanes are functionalized with polyethyleneglycol to have polyethyleneglycol functional groups? Clarification and/or correction requested.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-8, 10-12, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-25 of copending Application No. 10/826,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claimed identical method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-8, 11, 12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Feder (U. S. Patent 5,140,061) for the reasons of record set forth in paragraph 6 of the Office Action mailed March 30, 2004 (Paper No. 20040317). In addition the silicone elastomer produced by reaction of an alpha - omega -(dihydroxy) polydiorganosiloxane and an amino silane and/or amidosilane deemed to have either -NH<sub>2</sub> groups or -NH-groups unless shown otherwise. Further the silicone -elastomer deemed to have residual hydroxyl groups from either from alpha-omega -(dihydroxy) polydiorganosiloxane and/or from hydrolyzed aminosilane and/or amidosilane unless shown otherwise.

9. Applicant's arguments filed October 24, 2005 have been fully considered but they are not persuasive. In reference to rejection of claims 1-17 under 35 U.S.C. 102(b) as being anticipated by Feder (U. S. Patent 5,140,061), Applicants state that as previously explained that the silicone dispersion of Feder comprises the  $\alpha$  - $\omega$ - (dihydroxy)polydiorganosiloxane (component A) crosslinked into an elastomeric state upon removal of water under ambient conditions with a silane comprising a hydrolyzable amino or amido radical (component B) (citing, Feder, Column 3 and claim 1). The terminal hydroxyl groups of the  $\alpha$  - $\omega$  -(dihydroxy)polydiorganosiloxane react with the hydrolyzable amino or amido groups of the silane to form the crosslinked elastomeric product. There is no teaching or suggestion that the product itself of this crosslinking reaction comprises reactive groups that are free to react with flavor-active or odor-active taint compounds. Hence, the compositions of Feder lack one of the basic components of the compositions of the present invention, namely a "first functional groups which react with at least

Art Unit: 1773

one flavor-active or odor-active taint compound". Applicants further state that while the -NH groups in the crosslinked elastomer of Feder may have an affinity to react with the trichloroanisole, those groups may not be easily accessible to the trichloroanisole molecule. In support applicants submitted Declaration of Nicola Lake under 37 C.F.R. 1.132) stating that the amino groups of Feder are not accessible to a taint compound such as trichloroanisole because the amino groups of Feder is directly linked to an Si atom of silane.

These arguments are unpersuasive because the Declaration of Nicola Lake is an opinion. There is no data provided showing that Feder's coating does not react with trichloroanisole. Feder's coating in addition to -NH groups may have residual -OH groups which may be terminal groups and may react with trichloroanisole.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1773

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**D. S. Nakarani**  
**Primary Examiner**  
**Art Unit 1773**

Dsn  
January 9, 2006.